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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,026	09/03/1999	CHARLES A. PEYSER	020748.0103PTUS	6211
7590	07/18/2007		EXAMINER	
IP Department Patton Boggs, LLP Suite 3000 2001 Ross Avenue Dallas, TX 75201			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	
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			07/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/390,026	PEYSER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 07 May 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 39-58 is/are pending in the application.  
4a) Of the above claim(s) 40-44,47-53,56 and 57 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 39,45,46,54,55 and 58 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/7/2007 has been entered.

### ***Response to Amendment***

2. The applicant's amendment received on 5/7/2007 is acknowledged and entered. The applicant has added new claims 40-58.

### ***Response to Arguments***

3. Applicants arguments filed on 5/7/2007 (see remarks pages 6-9) against prior art rejection of claim 39 have been considered but are not persuasive for following reasons:

The applicant argues that Walker does not teach receiving a request for purchasing at least one telecommunication service. The examiner does not agree because the CPO in Walker corresponds to a request for a telecommunication service, that is a service request for connecting a call (see col.10, lines 20-65).

The applicant argues that Walker does not teach the limitation " generating an offer to provide at least one telecommunication service to the buyer.....". The

examiner disagrees because Walker teaches generating an offer from the provider of services in the form of either accepting the terms of the buyer's request in CPO or rejecting the terms of the buyer's request in the CPO.

The applicant argues that Walker does not teach, " receiving a response to the offer, wherein the response is associated with the buyer". The examiner disagrees because Walker teaches that in response to the provider's offer [either acceptance or rejection of terms of the buyer's request in the CPO] generates a response (see fig. 8b, col.10, lines 57-65) based on the test performed during determining step 845 leading to notifying the buyer [calling party] if the provider is willing or not willing to provide the services as per the terms of the buyer's request in the CPO. This response is associated with the buyer because the notification is sent to buyer if the provider is willing or not willing to provide the services as per the terms of the buyer's request in the CPO.

The applicant argues that Walker does not teach the limitation, " notifying the provider of the response and an identity of the buyer. The examiner disagrees because Walker does teach this limitation (see at least Fig.8b, step 870) that is notifying the provider about the full customer record to complete the call in accordance with the agreed terms.

The applicant further argues that the examiner has not presented a *prima facie* case for obviousness under 35 USC 103 (a) and that there is no apparent reason or suggestion to combine Walker and Abelow. The examiner disagrees. Walker, as analyzed above, teaches all the limitations, receiving a request...., generating an

offer..., receiving a response to the offer..., notifying the provider..... Walker also teaches providing, in step 870, full customer record from database 700 to enable the provider complete the call. Walker does not explicitly disclose that the prior use information is received from the buyer and using this information to generate the offer from the provider of services. However, in the same field of endeavor, Abelow discloses using prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer (see at least Abelow, Fig.1, block "30", " Use customer and user information to redesign and improve products, services", col.6, lines 46-65, col.8, lines 15-32, col.9, lines 38-46, col.12, lines 5-16[refers to telecommunication services, such as interactive home television, electronic books, wireless mobile electronic devices, etc.] and col.18, lines 11-50. Note: Abelow's teachings relate to analogous art. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Abelow's teachings are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In Abelow, just like in claim 39, user's past record of his use of products/services [products/services can include any types of services such as telecommunication services] is utilized to improve future offering of products/services to the user and therefore there is a need to receive information from the buyer about prior use products/services.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Walker and Abelow, as analyzed above, teaches all the limitations of claim 39 and the motivation to combine the teachings of both is within the objective reach of a person of an ordinary skilled in the art. Because by incorporating the teachings of using prior use information of the buyer in providing telecommunication services/generating offers would help the sellers/suppliers/vendors/manufacturers to incorporate the customer's feedback and provide better and improved designed services/products thus helping businesses to provide more satisfaction and improved services/products to buyers/customers, as clearly demonstrated in Abelow,

In view of the foregoing, the rejection of claim 39 as being unpatentable over Walker/Abelow is sustainable.

***Election by Original Presentation***

4. This application (newly added claims 40-58) contains claims directed to the following patentably distinct species:

Species 1: claims 39, 45-46, 54-55 and 58

Species 2: claims 39, 40, 42, 54-56

Species 3: claims 39, 41

Species 4: claims 39, 43

Species 5: claims 39, 44

Species 6: claims 39, 45-46

Species 7: claims 39, 47-50

Species 8: claims 39, 47,51

Species 9: claims 39, 52

Species 10: claims 39, 53

Species 11: claim 54,57

Species 12: claim 58-59

The species are independent or distinct because the above Species are directed to related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the species as claimed are distinct, for example, Species 1 and Species 2 are distinct since in Species 1 only one offer is required to be generated and in Species 2 *a plurality of offers are required to be generated with each offer being associated with a different provider*. Similarly all the above Species are distinct. Furthermore there is nothing of record to show that these species obvious variants.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 39 and 54 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Newly submitted claims 42-44,47-53, 56-57 are directed to species, that are independent or distinct from the species (claims 39, 45-46, 54-55 and 58) originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-44,47-53, 56-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**In view of the Election by original Presentation claims 39, 45-46, 54-55 and 58 are pending for examination.**

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 54-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 54-55 are directed to disembodied data structure which are per se not statutory. C.f. *In re Wamerdam*. Claims 54-55 claim a server and a database which can represent mere code/software that is a data structure resembling a data file without executing any functional changes due to an application program and resulting in an useful, concrete and tangible result. Functional descriptive material, in combination with a computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system is statutory i.e., a set of instructions in combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a computer memory, and *In re Lowery*, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete an tangible result (i.e. running an assembly line or executing a stock

transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material are:

- (a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.
- (b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.58 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39, 45-46; 54-55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Abelow.

With regards to claim 39, Walker discloses a method for purchasing telecommunication services, comprising:

receiving a request for purchasing at least one telecommunication service at a server, the request being associated with a buyer, generating an offer to provide the at least said telecommunication service to the buyer in response to receiving the request, the offer being associated with a provider of said telecommunication services, receiving a response to the offer, wherein the response is associated with the buyer, and notifying the provider of the response and an identity of the buyer (see at least FIG.1a, ' Calling party 110 " represents buyers' terminals, "CPO management system 100 [see also Fig.3] represents the sever which is requested for the required service by the buyer, and " Inter exchange carrier 1, 2....N" correspond to different providers of services, col.4; lines 39-52, receiving and processing CPOS for telephone calls from one or more calling parties, such as a calling party 110... ;and col.6, line 84-col.7, firm 9 , " ... Figs. 8a and lb, to provide (i) each CPO to the inter exchange carriers 120... ...". Also see col.3, lines 8-67. Note: Walker further discloses that on receiving responses from the number of inter exchange carriers, that is the service providers, the buyer is notified about the

offers and if the buyer accepts an offer the contract is completed, that is the seller is informed and services accepted from the seller for said buyer and payment made);

Walker does teach receiving information regarding prior use of telecommunication services of the buyer (see at least col.8, lines 11-28, and col.8, fine 59-col.9, fine 7, "**FIG. 4 illustrates an exemplary customer database 400 that preferably stores Information on each customer (calling party) of the CPO management system 900, Including biographical information and an indication of the local telephone company serving each customer.** ..... customer database 400 includes the customer's address in field 445, the manner in which the customer is bound in field 450, an indication of the local telephone company serving the customer in field 455 and the customer's telephone number in field 460. The telephone number stored in field 460 may be utilized, for example, as a customer identifier to index a historical database (not shown) of previous transactions associated with the customer. " Note: Walker's suggestion of utilizing the stored telephone number Information as a customer identifier to index a historical database correspond to receiving Information about prior use of telecommunication services of the users/buyers).

Walker does not explicitly disclose that the prior use information is received from the buyer and using this information to generate the offer from the provider of services. However, in the same field of endeavor, Abelow discloses using prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer (see at least Abelow, Fig.1, block "30", " Use customer and user information to redesign and improve products, services", col.6, lines 46-65, col.8, lines

15-32, col.9, lines 38-46, col.12, lines 5-16[refers to telecommunication services, such as interactive home television, electronic books, wireless mobile electronic devices, etc.] and col.18, lines 11-50. Further see at least Fig. 20 [760-Data collection], Fig.25, Fig.27B teach querying users/customers to get feedback with regards to their prior use of products/services). In view of Abelow, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Walker to incorporate the teachings of using prior use information of the buyer in providing telecommunication services/generating offers for telecommunication services to a potential buyer because, as clearly demonstrated in Abelow, it would help the sellers/suppliers/vendors/manufacturers to incorporate the customer's feedback and provide better and improved designed services/products thus helping businesses to provide more satisfaction and improved services/products to buyers/customers.

Regarding claim 45, its limitations are already covered in the analysis of claim 39 above (see at least Fig. 20 [760-Data collection], Fig.25, and Fig.27B. Abelow teaches querying users/customers to get feedback with regards to their prior use of products/services).

Regarding claim 46, its limitations are already covered in the analysis of claim 39 above. Abelow teaches using/evaluating [corresponds to estimating] prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer.

Regarding claims 54 and 58 their limitations are closely parallel to the limitations of claim 39 and are therefore analyzed and rejected on the basis of same rationale set forth for claim 39 above.

Regarding claim 55, Walker discloses a database in communication with the server (see fig.3. Data storage device 330 in communication with server 300 wherein the database device 330 can store buyer's requests [CPO], buyer data, qualification data and seller data [carrier].

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

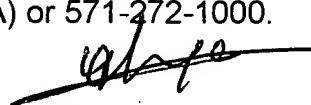
(i) Mashinsky (US Patent 6,226,365) teaches a system and method for telecommunication service requestors to submit request to a central server for flexible/efficient/economical routes for telephone calls and based upon the prior use of the service requesters [routes of interests based upon historical purchasing patterns] the server provides best offers from a plurality of carriers [service providers] (see at least Abstract, col.2, lines 18- 58, col.21, line 49-col.22, line 67).

(ii) Johnson et al. (US Patent 6,167,124) discloses a system and method for encouraging competition among service providers of telephone routes to service requesters for offering competitive rates (see at least Abstract, col.2, lines 45-58).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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